

U.S. Serial No. 10/743,577

Response to the Restriction of May 4, 2006

REMARKS

Claims 1-26 are pending and at issue in the above identified patent application. Of the claims at issue, claims 6, 10-13, and 26 have been withdrawn from consideration. The examiner alleges claims 1-30 are directed to three inventions under 35 U.S.C. § 121. Specifically, the examiner requires a restriction election between claims 1-17, drawn to a vehicle brace for a vehicle (Invention I), claims 8-25, drawn to a method of operating a vehicle brace (Invention II), and claim 26, drawn to a loading dock (Invention III). The applicants believe the examiner intended Invention II to include claims 18-25 and respond accordingly.

As set forth in detail below, without denying that the claims are patentably distinct, the applicant *traverses* this restriction requirement and reconsideration and withdrawal of the restriction requirement is requested in view of the following remarks.

Election/Restrictions

As an initial matter, the applicant notes that the examiner attempts to support a requirement for restriction between Inventions I and II, a product and process of use, under M.P.E.P. § 806.05(h). To fall under this section of the M.P.E.P., the examiner must show that (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.” Furthermore, “the burden is on the examiner to support a viable alternative use or withdraw the requirement.” M.P.E.P. § 806.05(e). The restriction requirement does not meet this burden.

In this instance, the examiner alleges that the process of invention II “can be practiced with any device that would slow the vehicle, such as a bumper mounted on the loading dock.” The applicants, however, note that claim 1 recites, *inter alia*, a vehicle brace for a vehicle including a support member that “appreciably slows the descent of the vehicle when

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the vehicle moves downward,” while claim 18 similarly recites, *inter alia*, a method of operating a vehicle brace in response to downward movement of a vehicle’s rear edge, by “appreciably slowing the descent of the vehicle’s rear edge by having the vehicle brace exert a reactive force upward against the vehicle’s rear edge.” While a bumper may slow the horizontal movement of a vehicle toward a loading dock, it does not appreciably slow the vertical descent of the vehicle. Therefore, the product to practice the process as alleged by the examiner is unclear and impractical. Accordingly, the examiner has not met the burden of providing a viable example of the material differences between the two alleged groupings, as required.

As such, the examiner clearly fails to meet the requirements of M.P.E.P. § 806.05(h) and, on this basis alone, the restriction requirement must be withdrawn.

Furthermore, the M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). In this instance, although the examiner argues that the groups of claims identified in the Office action are patentably distinct, it fails to even allege, let alone demonstrate that a serious burden would be placed on the examiner if election were not required. While, the Office action apparently identifies a burden by stating that claims 1-17 are classified in class 414, subclass 401, and that claims 18-25 are classified in class 414, subclass 809, the applicants are respectfully confused as to, how it can be alleged that a search in both of these subclasses is a serious burden on the examiner. In fact, it seems likely that the examiner would search both of the subclasses to thoroughly search the invention anyway. Accordingly, the applicants respectfully submit that there can be no serious burden upon the examiner in reviewing all of the claims simultaneously since the

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examiner will likely be searching a single class in full anyway in reference to any elected one of the claim sets.

If there is a serious burden in the present application, it is on the assignee of this application as a result of this restriction requirement. Unless the restriction requirement is withdrawn, the assignee must not only prosecute as many as three separate applications, which multiplies the cost and time of obtaining protection for the inventive subject matter, but it must also then pay separate maintenance fees for each of the issued patents. It is respectfully submitted that the burden of the expense incurred in order to obtain three different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

In summary, the Office action fails meet the requirements of M.P.E.P. § 806.05(h), and moreover fails to address the second required criteria for restriction set forth in the M.P.E.P. § 803. In view of the following mandate, this failure renders the restriction requirement improper:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). Therefore, the applicants request that the requirement for restriction be withdrawn.

Election under 37 C.F.R. § 1.143

Subject to the traversal of the restriction requirement and in accordance with the requirements of 37 C.F.R. § 1.143, the applicant hereby provisionally elects Invention II (Claims 18-25). Furthermore, assuming the restriction requirement is withdrawn, the applicants hereby provisionally elect the species of FIGS. 1-6, without traverse, with claims 1-5, 7-9, 14-25 readable thereon. At least claims 1, 4, 15, and 18 are generic.

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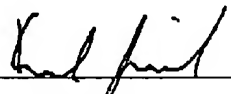
In making this provisional election, the applicants do not intend to abandon the scope of non-elected claims, but may pursue the non-elected claims in a divisional application if the restriction requirement is not withdrawn upon reconsideration.

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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